

## **DETAILED ACTION**

### **Status of Claims**

1. This communication is a First Office Action on the merits in reply to application number 10/597,284 filed on July 19, 2006.
2. Claims 1-22 are currently pending and have been examined.

### **Priority**

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### **Information Disclosure Statement**

4. The information disclosure statement (IDS) submitted on 07/19/2006 appears to be in compliance with the provisions of 37 CFR 1.97 and has been entered into the record. Accordingly, the information disclosure statement is being considered by the examiner.

### **Specification**

5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

### **Claim Objections**

6. Claims 1-22 are objected to for the following reason(s): The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should

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be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m). Appropriate correction is required.

7. Claim 9 is objected to for the following reason(s): Claim 9 appears to contain a minor grammatical error such that "...the steps of sending..." should be recited as "...the step of sending..." Appropriate correction is required.

#### **Claim Rejections - 35 USC § 112**

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 13-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. As per claims 13-22 the various recited means (or steps) plus function limitations invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

Applicant is required to:

- Amend the claim so that the limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or
- State on the record where the corresponding structure, material, or acts are set forth in the written description or the specification that perform the claimed function.

For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

### Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

13. Claims 1-12 are drawn to a *computerized method for providing a personalized list of future meetings*.

However, the recited method steps are drawn to non-statutory subject matter because the recited steps fail to overcome the machine-or-transformation test, as the recited steps are (1) not tied to a particular machine or apparatus and (2) do not produce a transformation the underlying subject matter (such as an article or materials) to a different state or thing. Furthermore, and as discussed below, mere recitation of a machine ("computerized method") in the preamble is by itself insufficient to render the claimed invention statutory under 35 U.S.C. § 101.

Based on Supreme Court precedent, a process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplishes the method steps or by positively reciting the subject matter being transformed, for example by identifying the material that is being changed to a different state.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) It is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See *Benson*, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines.');

*Diehr*, 450 U.S. at 192 (holding that use of mathematical formula

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in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also *Flook*, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); *Cochrane v. Deener*, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject- matter to be transformed and reduced to a different state or thing.'). A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008)).

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)). Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495).

#### **Claim Rejections - 35 USC § 102**

**14.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**15. Claims 1, 2, 9, 11-14, and 22 are rejected under 35 U.S.C. 102(b) as unpatentable as being anticipated by Margeson et al. (US 2002/0178086, hereafter referred to as “Margeson”).**

**16. Claims 1/13**

As per claim 1, Margeson teaches a *computerized method for providing a personalized list of future meetings per subject per user based upon the user's preferences* (paragraph 59), comprising:

- *obtaining a profile listing various meeting preferences of a user* (paragraphs 23 and 59: employee selects a future seminar or seminar topic of interest; list of preferred seminars and/or seminary topics of interest; employee preferences);
- *obtaining a list of meetings corresponding to at least a portion of the user's profile, for preparation of a recommended meeting list* (paragraphs 25 and 59: seminars of interest);  
*and*
- *sending the user the list of recommended meetings* (paragraphs 36 and 59: employee may choose to be notified as certain seminars of interest become available; employee selects desired method of notification communication, such as email or fax).

As per claim 13, Margeson teaches a system for performing the method of claim 1 (Figures 1 and 2: paragraphs 6, 7, 17-20, 29-31, 42, and 45).

**17. As per claims 2/14, Margeson further teaches communicating with said user (paragraphs 22, 27, 30, 35, and 59: teach various features for communicating with a user); presenting questions to said user designed to extract the user's preferences for meetings (paragraph 59: employee may be asked to respond to precise survey questions); and assembling an explicit user profile from the user's answer to the questions (paragraphs 23, 53, 54, 61, 64: teaches creating and updating user/employee profile).**

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**18.** As per claim 9, Margeson further teaches *wherein said steps of sending includes the steps of: connecting to the Internet* (paragraphs 30, 31 and 45-47: teaches Internet based connectivity functionality of the method/system); *and emailing the list of recommended meetings to said user* (paragraphs 56, 59, 79, 82, 84: list of seminars; paragraph 56: employee is presented with a list of upcoming seminars; paragraph 59: teaches email communication that may be used for notifying employee of seminars of interest).

**19.** As per claims 11/22, Margeson further teaches *wherein said step of obtaining a list of meetings, further includes the step of: retrieving location specific information for each meeting obtained in response to a prior request from said user for such information, whereby such information is included with the meeting information* (paragraphs 50, 56, 59, 60, and 65).

**20.** As per claim 12, Margeson further teaches *wherein said step of sending a list of meetings, further includes the steps of: asking said user if they wish to receive location specific information for meetings selected from the list of recommended meetings; retrieving in response to a request by said user, location specific information for meetings selected by said user; sending the location specific information to said user* (paragraphs 50, 56, 59, 60, and 65).

#### **Claim Rejections - 35 USC § 103**

**21.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**22.** This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned

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at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**23. Claims 3-8, 10, and 15-21 are rejected under 35 U.S.C. 103(a) as unpatentable over Margeson et al. (US 2002/0178086, hereafter referred to as “Margeson”), as applied to claims 1, 2, 9, 11-14, and 22 above, in further view of Tomsen (US 2002/0056109).**

**24. Claims 3/15:** Margeson teaches the limitations of claims 1/13 as shown above.

Margeson further teaches *wherein obtaining a profile of the user's meeting preferences includes the steps of: preparing a listing of various topics relative to a typical user's preferences in selecting meetings to attend or participate* (Margeson at paragraphs 23 and 59: preferences, tendencies, capabilities, and/or the like), but does not expressly teach *monitoring Website activities of said user to obtain a listing of Websites said user contacts for information pertaining to meetings and assembling an implicit user profile for said user by relating said topic listing to the listing of Website activities obtained from said monitoring step.*

However, Tomsen, as combined with Margeson, teaches *monitoring Website activities of said user to obtain a listing of Websites said user contacts for information pertaining to meetings; and assembling an implicit user profile for said user by relating said topic listing to the listing of Website activities obtained from said monitoring step* (Tomsen at paragraphs 12, 13, and 49). Furthermore, user profiling and targeted content delivery based on said profiling is old and well known in the art.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of Margeson with the website monitoring and implicit profile assemblage steps, as taught by Tomsen, in order to provide the benefit of more effective/optimized/targeted content delivery (i.e., personalization) to the profiled user (Tomsen at paragraphs 5, 11, and 12), and further obvious because

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the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**25. Claims 4/16:** Margeson teaches the limitations of claims 1/13 as shown above.

Margeson further teaches *wherein obtaining a profile of the user's meeting preferences includes the steps of: preparing a listing of various topics relative to a typical user's preferences in selecting meetings to attend or participate* (Margeson at paragraphs 23 and 59; preferences, tendencies, capabilities, and/or the like); *presenting questions based upon said topic listing to said user to extract the user's preferences for meetings and assembling an explicit user profile from the user's answers to the questions* (Margeson at paragraphs 23, 53, 59, 61, and 64; see also, Figure 3, element 308), but does not expressly teach *monitoring Website activities of said user to obtain a listing of Websites said user contacts for information pertaining to meetings; constructing an implicit user profile for said user by relating said topic listing to the listing of Website activities obtained from said monitoring step; and combining said explicit and implicit user profiles to provide said user profile for use in said step of obtaining a list of meetings.*

However, Tomsen, as combined with Margeson, teaches *monitoring Website activities of said user to obtain a listing of Websites said user contacts for information pertaining to meetings; constructing an implicit user profile for said user by relating said topic listing to the listing of Website activities obtained from said monitoring step; and combining said explicit and implicit user profiles to provide said user profile for use in said step of obtaining a list of meetings* (Tomsen at paragraphs 12, 13, and 48-53; see also, Margeson at paragraph 56). Furthermore, user profiling and targeted content delivery based on said profiling, including implicit/explicit information gathered/collected/inferred about a user, is old and well known in the art.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of Margeson with the website monitoring and implicit/explicit profiling, as taught by Tomsen, in order to provide the benefit of more effective/optimized/targeted content delivery (i.e., personalization) to the profiled user (Tomsen at paragraphs 5, 11, and 12), and further obvious because the claimed

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invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**26. Claims 5/6/7/8:** Margeson and Margeson/Tomsen teaches the limitations of claims 1/2 and 3/4, respectively, as shown above.

With respect to the limitation *wherein obtaining a list of meetings includes connecting to the Internet and searching the Web for meetings having some association with said (implicit/explicit/combined explicit/implicit) user profile*, Margeson further teaches *connecting to the Internet* (paragraphs 30, 31 and 45-47: teaches Internet based connectivity functionality of the method/system) and a *system for searching seminar offerings* (paragraphs 6 and 56) through a central reservations engine database which may be connected to the internet (paragraphs 29), but does not expressly teach *searching the Web for meetings having some association with said (explicit) user profile*, as claimed.

However, OFFICIAL NOTICE IS TAKEN that executing a search query over a network (e.g., Web, internet, intranet, WAN, LAN, and the like) based on predetermined criteria (e.g., profile) is old and well known in the art. Furthermore, Margeson clearly provides the system, method, and suggestion for conducting search queries in a networked computing environment (paragraphs 6, 30, 31, and 45-57), and such step could have easily been performed by one skilled in the art using well known methods.

Therefore, it would have been obvious to one skilled in the art to further include a step for *searching the Web for meetings having some association with said (implicit/explicit/combined explicit/implicit) user profile*, as claimed, in order to provide the benefit of more effective content delivery (i.e., personalization) to the profiled user (Tomsen at paragraphs 5, 11, and 12), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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**27. Claims 10/21:** Margeson teaches the limitations of claims 1/13 as shown above.

Margeson does not expressly teach *wherein the step of obtaining a list of meetings includes matching the preferences of said user against other users; and generating a recommended meetings list for said user based upon meetings selected by said other users having preferences similar to those of said user.*

However, Tomsen, as combined with Margeson, teaches *wherein the step of obtaining a list of meetings includes matching the preferences of said user against other users; and generating a recommended meetings list for said user based upon meetings selected by said other users having preferences similar to those of said user* (Tomsen at paragraph 52). Furthermore, delivering targeted content to a user based in part on similarity of the user's preferences, profile, affiliation, etc., to another user's preferences, profile, affiliation, etc., is old and well known in the art.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of Margeson with the matching and generating steps, as taught by Tomsen, in order to provide the benefit of more effective/optimized/targeted content delivery (i.e., personalization) to the profiled user (Tomsen at paragraphs 5, 11, and 12), and further obvious because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**28. Claims 17-20:** Claims 17-20 are drawn to the system for performing the methods of claims 5-8, respectively. Accordingly, Margeson teaches a system for performing the methods of claims 5-8 (Margeson at Figures 1 and 2; see also, paragraphs 6, 7, 17-20, 29-31, 42, and 45).

### **Conclusion**

**29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:**

- MICROSTRATEGY: MicroStrategy launches Strategy.com, the world's first personal intelligence network. M2 Presswire. Coventry: Jun 29, 199. pg. 1: discloses features for collecting a real-time catalog of user preferences and profiles for facilitating personalized content delivery

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to users (page 1) regarding topics of interest (page 2) via the internet, telephone, and wireless devices (pages 1-2).

- Thomas et al. (US 2003/0093794): teaches a method/system for personal information retrieval, update, and presentation, including features for generating a user's profile manually or automatically and analyzing/matching the content with the predefined user's profile (see at least paragraphs 11 and 18-21).

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Timothy A. Padot whose telephone number is 571.270.1252. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Kambiz Abdi can be reached at 571.272.6702.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866.217.9197 (toll-free).

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Examiner, Art Unit 3624

04/19/2010

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